

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the following comments.

The sole issue for consideration is the rejection of claims 1, 3-6 and 8-10 under 35 USC § 103(a) as being obvious over Gessner et al. ("Gessner"), U.S. Patent No. 5,997,989. In response, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Applicant again submits that Gessner alone could not have rendered the subject matter of the instant claims *prima facie* obvious to persons skilled in the art, as a matter of law. The Examiner concedes that Gessner does not teach that the staple fibers should be made of polypropylene, as instantly claimed. The Examiner cites no secondary reference teaching that the staple fibers should be made of polypropylene. Applicant submits this ends the matter, and that no *prima facie* case has been made out.

Applicant would call the attention of the Examiner to the recent decision in *In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). In that case, the Board of Appeals and Interferences held in a manner similar to the Examiner's findings here, that is:

"The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art *without any specific hint or suggestion in a particular reference.*"

[Emphasis added.] *See, Lee*, 61 USPQ2d at 1432.

The Court of Appeals for the Federal Circuit (“Federal Circuit”) *disagreed*, holding:

“[T]he Board rejected the need for ‘any specific hint or suggestion in a particular reference’ to support the combination of the [cited] references. *Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.*”

[Again, emphasis added.] *See, Lee*, 61 USPQ2d at 1434.

The Federal Circuit explained:

“This court explained in *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697, that ‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’ The Board’s findings must extend to all material facts and must be documented on the record, lest the ‘haze of so-called expertise’ acquire insulation from accountability. ‘Common knowledge and common sense,’ even if assumed to derive from the agency’s expertise, do not substitute for authority when the law requires authority.”

[Unbolded underline in original and all other emphasis added.] *See, Lee*, 61 USPQ2d at 1435.

A material fact in this case is the motivation of a person having ordinary skill in the art to use polypropylene for the staple fibers. The Examiner concedes that the Gessner reference is silent on this issue, and the Examiner cites no secondary reference to show that such use would have been obvious. Nevertheless, the Examiner rejects the claims, taking the position that:

“[T]he skilled artisan would have found it *obvious to utilize* polypropylene because it is already used in other layers of Gessner.

Using the same polymer would simply (sic) production and ensure compatibility of layers.”

The Examiner’s position has no support whatsoever on the record. The Examiner simply has used Applicant’s disclosure against him, and concluded obviousness rather than proving it objectively. Such action of finding it “obvious to utilize” propylene is nothing more than the imposition of an “obvious to try” standard of obviousness, which is presumptively improper. In finding it “obvious to utilize” polypropylene, the Examiner is simply finding it “obvious to try” polypropylene, which, again, is presumptively improper. The fact that the Examiner finds it obvious to utilize polypropylene for common sense reasons, i.e., to simplify production and ensure compatibility of layers,” is of no help in the absence of objective evidence in support.

Respectfully, this rejection is untenable, and Applicant respectfully requests that the Examiner reconsider and withdraw it. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,
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